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6713-Dr. Wi-ar

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefore. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Claims 16-23 and 25-30 have been amended. Claims 16-30 are still pending. It is believed that no new matter has been added.

35 U.S.C. 112, second paragraph rejection

Claims 16-29 were rejected by the examiner as being indefinite. It is believed that paragraphs (i), (iii), (iv), (vii) and (viii) have been addressed by the amendments made above. The applicants address below the rejections made in paragraphs (ii), (v) and (vi):

(ii) MPEP 2173.05 (New Terminology) includes the passage:

"During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Prater, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). See also MPEP § 2111 - § 2111.01. When the specification states that the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. In re Zletz, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989)."

The term "modified phyllosilicates" is described in detail throughout the specification, most particularly from page 9, line 6 through page 11, line 20 (see e.g. page 10, lines 23-25 - "Modified phyllosilicates for the purposes of the present invention phyllosilicates...whose organophilicity (also: lipophilicity) has been increased...")

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(v), (vi) Since the terms "microfine", "micronized" and "polymer particles" are not defined in the specification the words are given their "plain meaning" (see MPEP 2111.01 and also "A claim term takes on its ordinary and accustomed meaning unless the patentee demonstrated an intent to deviate from that meaning by redefining the term in the intrinsic record using words of 'manifest exclusion or restriction,' the U.S. Court of Appeals for the Federal Circuit held June 21 (*Teleflex Inc. v. Ficosa North America Corp.*, Fed. Cir., No. 01-1372, 6/21/02)."

Given the plain meaning, it is unclear what are the reasons the examiner believes that a "standard for ascertaining the requisite degree" is necessary for one of ordinary skill in the art to be apprised of the scope of the invention especially in light of the fact that the "microfine polymer particles" and "micronized, inorganic pigments" are further limited in that they must be pigments and that these pigments selected must be suitable for the water-in-oil emulsion defined by claim 16 (i.e. "...the pending claims must be given the broadest reasonable interpretation consistent with the specification..." from MPEP 2173.05 cited above).

With respect to (ii), (v) and (vi), the applicants are merely using terminology which is supported in the specification, it is unclear what the examiner would find to be permissible terminology.

With this in mind, section 2173.02 of the MPEP is reproduced below:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, *not whether more suitable language or modes of expression are available*. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. *Some latitude in the manner of expression and the aptness of*

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terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement. (see MPEP 2173.02)

35 U.S.C. 103(a) rejection

Claims 16-30 have been rejected by the examiner as being obvious over Fänger et al. (U.S. Patent 6,153,204) in view of Msika et al. (U.S. Patent 5,939,054).

The examiner apparently acknowledges that Fänger et al. does not teach the inclusion of at least one modified phyllosilicate pigment particles which have amphiphilic character.

However, when considering Fänger et al. as a whole, it is directed toward a process of reducing stickiness or a cosmetic or topical dermatological preparation which is achieved by adding a hydrophilic starch esterified with one or more n-octenylsuccinate radicals.

Although there are six specific examples which disclose a water-in-oil emulsion, each of the examples contain the hydrophilic starch esterified with one or more n-octenylsuccinate radicals (which are not disclosed to be pigments) which is consistent with the direction of their teachings; there is no generic teachings as to the amount of ingredients envisioned for a water-in-oil emulsion (i.e. limitations a) and d) as in the applicants invention.

The examples of Fänger et al. contain either 4.0% by weight PEG-7 hydrogenated castor oil (examples 1-4) or 3.5% by weight polyglyceryl-3-dioleate (example 5) each of which are well known emulsifiers and as such are well in excess of the 0.5% possible in claim 16 and totally counter to the requirement in claim 17 that the water-in-oil emulsion is emulsifier free.

Example 6 does not contain 10-70% by weight of an oil phase with fatty acid/wax components

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which melt above a temperature of 40°C.

Msika et al. does not remedy these additional differences cited above nor does it remedy the difference with regards to phyllosilicate pigment particles. Other than the supposition that both the invention of Fänger et al. and Msika et al. could loosely be considered to be cosmetic or pharmaceutical preparations, there is little in Msika et al. which suggest their composition is similar to that of Fänger et al. and as such would make it appropriate to "pick and choose" selected elements for substitution.

The examiner states that quaternium 14 and 18 are used in Msika et al. However, there is no indication or explanation proffered by the examiner as to why it would be expected that the quaternium 14 and 18 would be expected to position itself at the water/oil interface when substituted into the emulsions of Fänger et al.

The examiner also states that Msika et al. teaches a fatty phase as comprising 20-60% of the composition. However, it is not stated how this relates to the applicants limitation that the oil phase comprises 10 to 70% by weight of fatty and/or wax *components which melt at a temperature of 40°C.*

The examiner also states that "Stick forms of the emulsions are disclosed. Emulsions comprising no emulsifiers are exemplified (see col. 12, line 55)." This incorrect as this "Total Sunblock Stick" is not an emulsion (what constitutes the aqueous phase?).

Moreover, when viewing the teachings of Msika et al. as a whole, it is clear that their invention is directed toward a sunscreen composition which contains a synergistic mixture of titanium and/or zinc oxide particles. There is no teaching or suggesting to select a single element out of their composition and substitute it into the invention of Fänger et al.

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Further still, it is unclear why one of ordinary skill in the art would seek to substitute a gelling agent (i.e. Msika et al.'s "teaching") into a composition which is intended to reduce the stickiness of a cosmetic or topical dermatological preparation, i.e. the proposed modification cannot render the prior unsatisfactory for its intended purpose (see MPEP 2143.01 – page 2100-124)

Closing

Early and favorable action is earnestly solicited.

Respectfully submitted,
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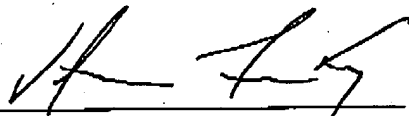
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (8 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 17 September 2002

By: 
Vilma I. Fernandez

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COPY OF CLAIMS SHOWING AMENDMENTS MADE

16. Cosmetic or dermatological stick preparation[s], which [are finely disperse] is a water-in-oil [systems] emulsion, comprising
- an oil phase which comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C,
 - a water phase,
 - at least one modified phyllosilicate pigment particles which exhibits both hydrophilic and lipophilic properties, which thus has amphiphilic character and positions itself at the water/oil interface, and
 - at most 0.5% by weight, based on the total weight of the preparations, of one or more emulsifiers.
17. Preparation according to Claim 16, [characterized in that] wherein it is emulsifier-free.
18. Preparation according to Claim 16, [characterized in that] wherein the water phase content is [chosen from the range] from 15 to 60% by weight, based on the total weight of the preparations.
19. Preparation according to claim 16, [characterized in that] wherein further cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients are present.
20. Preparation according to claim 16 or 19, [characterized in that] wherein the content of modified phyllosilicate pigment particles used is between 0.1% by weight and 30% by weight, based on the total weight of the preparations.
21. Preparation according to claim 16 or 19, [characterized in that] wherein the modified phyllosilicate pigment particle(s) is/are chosen from the group which includes modified smectites, modified bentonites, modified montmorillonites and modified hectorites.
22. Preparation according to claim 21, [characterized in that] wherein the modified phyllosilicate pigment particle(s) is/are a modified hectorite selected from the group consisting of stearylquaternium hectorite and quaternium-18 hectorite.

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23. Preparation according to claim 16 or 19, [characterized in that] wherein, in addition to one or more modified phyllosilicate pigment particle(s), (a) further pigment(s) are present which are selected from the group consisting of modified polysaccharide, microfine polymer particles, boron nitride and micronized, inorganic pigments where the pigments can be present either individually or in a mixture.
24. Preparation according to claim 23, wherein the micronized, inorganic pigments is/are an amphiphilic metal oxide(s).
25. Preparation according to claim 24, wherein the amphiphilic metal oxide(s) are selected from the group consisting of titanium dioxide, zinc oxide, iron oxides or iron mixed oxides, silicon dioxide [or] and silicates.
26. Preparation according to claim 16 or 19, [characterized in that] wherein it is in the form of a make-up and/or cosmetic stick, and additionally comprises at least one dye and/or one color pigment.
27. Preparation according to claim 26, [characterized in that] wherein the make-up and/or cosmetic stick form is selected from the group consisting of eyebrow pencil, kohl pencil, eyeshadow pencil, eyeliner pencil, concealer stick, powder stick[, decorative stick] and [care] lipstick.
28. Preparation according to claim 16 or 19, [characterized in that] wherein it comprises one or more additives or active ingredients selected from the group consisting of astringents, antioxidants, UV filter substances, antimicrobial substances and substances effective against acne.
29. Method for the preparation of Pickering emulsion sticks, [characterized in that] wherein modified phyllosilicate pigment particles are dispersed in the oil phase, which comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C, and, optionally, cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients, with uniform stirring and optionally with heating, and, during the uniform stirring, the water phase, which, optionally comprises cosmetic or pharmaceutical

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auxiliaries, additives and/or active ingredients, is mixed with the oil phase.

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30. A method of treating the skin comprising applying to the [body] skin a preparation according to claim 16.